



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,595	08/01/2000	Scott W. Rau	47004.000049	5920

21967 7590 09/13/2004

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,595

Applicant(s)

RAU ET AL.

Examiner

Andrew J. Fischer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicants' Appeal Brief filed June 17, 2004 is acknowledged. Accordingly, claims 26-40 remain pending.
2. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.
3. In light of Applicants' Appeal Brief filed June 17, 2004, prosecution is hereby reopened. Applicants appeal brief has overcome the new matter rejections. To clarify this matter and to make other modifications, a third Final Office Action is set forth below.
4. To avoid abandonment of the application, Applicants must exercise one of the following two options:
 - (1) File a reply under 37 C.F.R. §1.113; or,
 - (2) Request reinstatement of the appeal.
5. If reinstatement of the appeal is requested, Applicants are reminded should they file their Appeal Brief on or after September 13, 2004, their Appeal Brief must comply with the new requirements for appeals announced in the Federal Register, Vol. 69, No. 155, Pg 49960 (August 12, 2004) and that such request must be accompanied by a supplemental appeal brief. However, no new amendments, affidavits (37 C.F.R. §§ 1.130, 1.131 or 1.132), or other evidence is permitted. See 37 C.F.R. §1.193(b)(2).

Claim Rejections - 35 USC §102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 26-40 are rejected under 35 U.S.C. §102(b) as being anticipated by Hennige (U.S. 5,276,311). Hennige discloses an ordinary credit transaction including receiving by a transponder server of a credit network at least some transponder identification information (credit account number) emitted from a transponder (contacts 100 in the credit card) substantially upon presentation of both the transponder and a transaction for payment at a POS device, the payment comprises a payment amount (inherent in all payments); receiving (at the credit authorization agency) at least some financial account information (the account number transmitted from the merchant) linked to the transponder identification information in an account table (the table includes account holder's name, billing address, available balance and credit, etc.); determining authorization based on the payment amount (inherent since a credit card company would not authorize a \$40,000 purchase if the customer had only a \$10,000 available line of credit); communicating authorization to the POS device (approving or rejecting the credit purchase); paying the authorized payment amount to a merchant account associated with a

Art Unit: 3627

merchant (the credit card company pays the merchant); issuing the transponder (credit card) to the holder of the account (the consumer); receiving the transponder identification information from multiple POS devices (inherent since the consumer can use his or her credit card at multiple POS devices); the account type is a credit card; the transponder is embedded in a transaction card (contacts 100 are embedded in the overall card); and registering the financial account information (activating the credit card) via a network registration interface (a telephone).

8. Claims 26-40 are alternatively rejected under 35 U.S.C. §102(b) as being anticipated by Jun et. al. (U.S. 5,828,044) ("Jun"). Jun discloses the claimed invention including an RF transponder.

9. Claims 26-40 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Wynn (U.S. 5,859,419).

Claim Rejections - 35 USC §103

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 26-40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Hennige.¹ It is the Examiner's principle position that the claims are anticipated because the receiving by a server of an issuing bank is inherent.

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

Art Unit: 3627

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hennige to include having the transponder server be of an issuing bank. Such a modification would have encouraged customers to use only a their bank resulting in small fees to the user.

12. Claims 26-40, as understood by the Examiner, are also alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Jun. It is the Examiner's principle position that the claims are anticipated because the receiving by a server of an issuing bank is inherent.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jun to include having the transponder server be of an issuing bank. Such a modification would have encouraged customers to use only a their bank resulting in small fees to the user.

13. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.² First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants

² See the First Non Final Office Action mailed May 16, 2002, Paragraph No. 13; the First Final Office Action mailed August 29, 2002, Paragraph No. 12; the Second Non Final Office Action mailed March 4, 2003, Paragraph No. 13; and the Second Final Office Action mailed January 21, 2004, Paragraph No. 12.

Art Unit: 3627

have also not pointed to a term or terms in a claim with which to draw in those statements³ with the required clarity, deliberateness, and precision.⁴ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁵ Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicants have decided not to be their own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023,

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁵ See Note 2.

Art Unit: 3627

1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁶

14. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.⁷ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.⁸ Finally, the following list is not intended to be exhaustive in any way:

Server: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.⁹ **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.* **Computer:** “Any machine that

⁶ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

⁷ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definitions to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

⁸ See e.g. *Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

⁹ Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its

Art Unit: 3627

does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

Data “Plural of the Latin datum, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” *Id.*

Interface “The point at which a connection is made between two elements so that they can work with each other.” *Id.*

Network: “A group of computers and associated network devices that are connected by communications facilities.” *Id.*

Radio Frequency “Abbreviated RF. The portion of the electromagnetic spectrum with frequencies between 3 kilohertz and 300 gigahertz. This corresponds to wavelengths between 30 kilometers and .03 millimeter.” *Id.*

Table “1. In programming, a data structure usually consisting of a list of entries, each entry being identified by a unique key and containing a set of related values. A table is often implemented in an array of records, a linked list, or (in more primitive languages) several arrays of different data types all using a common indexing scheme. 2. In relational databases, a data structure characterized by rows and columns, with data occupying or potentially occupying each cell formed by a row-column intersection. The table is the underlying structure of a relation.” *Id.*

Relational Model “A data model in which the data is organized in relations (tables). This is the model implemented in most modern database management systems.” *Id.* **Relational Database**

“A database or database management system that stores information in tables—rows and columns of data—and conducts searches by using data in specified columns of one table to find

appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and

Art Unit: 3627

additional data in another table. In a relational database, the rows of a table represent records (collections of information about separate items) and the columns represent fields (particular attributes of a record). In conducting searches, a relational database matches information from a field in one table with information in a corresponding field of another table to produce a third table that combines requested data from both tables. . . . Microcomputer database products typically are relational databases. *Compare* flat-file database, inverted-list database.” *Id.*

Information “2 a . . . (3): FACTS, DATA” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Registering “c : to record automatically : indicate” *Id.*

Transponder “(3) (broadband local area networks) A device that responds to a physical or electrical stimulus and emits an electrical signal in response to the stimulus.” The IEEE Standards Standard Dictionary of Electrical and Electronic Terms, 6th Ed., IEEE, Inc., New York, NY, 12/1997.

Transponder “A combination transmitter-receiver that automatically transmits an identification signal whenever it receives an interrogating signal. The term is an acronym for *transmitter* and *responder*.” The Illustrated Dictionary of Electronics, 6th Ed., TAB Books, Blue Ridge Summit, PA, 12/1994.

Response to Arguments

15. Applicants’ arguments filed June 17, 2004 and not reflected in this Office Action have been fully considered but they are not persuasive.

Art Unit: 3627

§112 1st Paragraph and New Matter

16. Because Applicant does not claim a “separate” authorization unit as claimed in the divisional application 10/143,581, and because “an authorization unit” is at the very least integral to a POS system, the authorization unit must be inherently disclosed. Because they are inherent in all POS systems, the new matter rejections on this particular matter have been withdrawn.

17. In the previous office action (the Second Final Office Action), the Examiner noted that Applicants’ original filed specification did not disclose “receiving by a transponder server of at least one issuing bank ... at least some transponder information”

18. Applicants First Appeal Brief states that “Those of ordinary skill in the art know that credit card transactions are authorized by the issuing bank or financial institution that issued or acquired the credit card account Such issuing banks and/or financial institutions are typically part of credit networks.”¹⁰ Because one of ordinary skill in the art knows that credit card transactions are authorized by an issuing bank, the Examiner finds that *any* credit card transaction must be “of” or associated with its issuing bank. Because such features are inherent in all credit transactions (thus including Applicants’), this particular 35 U.S.C. 112 1st paragraph rejection is hereby withdrawn.

Hennige

19. Applicants’ arguments regarding Hennige have been considered but are not persuasive. The Examiner relies on *In re Morris* and the definitions noted in this Office Action. The

¹⁰ Applicants’ First Appeal Brief, June 17, 2004, Page 10, ~lines 8-12.

Art Unit: 3627

Examiner respectfully disagrees that his interpretation of “transponder” is “impermissibly overly broad”¹¹ The Examiner maintains his position of “transponder” as noted in this Office Action.

20. Additionally, the Examiner interpretation does not render the claims as being meaningless as suggested by Applicants. Instead, the Examiner interpretation renders the claims rejected. To the extent that rejected claims are in effect meaningless, the Examiner agrees with Applicants’ statement.

Conclusion

21. Applicants’ amendment filed June 6, 2003 necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

¹¹ *Id.*, Page 12, ~lines 4-6.

Art Unit: 3627

22. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

23. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

25. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written

Art Unit: 3627

description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art).

Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their arguments in their First Appeal Brief traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹² the Examiner again respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the

¹² *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

Art Unit: 3627

Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
September 8, 2004